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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,346	01/18/2002	Bruce B. Fitts	RGP-0072	9834
23413	7590	07/09/2004	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,346

Applicant(s)

FITTS ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13 and 15-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13 and 15-89 with independent 1 being broadest is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to Paper filed on 09 June 2004.

I. The record shows that the specification has been amended. If a new matter is found, please see the authority stated in *Tronzo v. Biomet Inc.*, 41 USPQ2d 1403.

II. Applicants (1) state that no new matter is added in the amendment filed on 09 June 2004 and show support and (2) provide no statement for other amendments and show support.

III. There are 87 claims in eight groups of the claims (1-6 and 8-10), (11-13 and 15-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) as stated on the record and paid for with independent claim 1 being broadest. They are not considered to be patentably different or distinct. Therefore, no election of species or restriction is made. Accordingly, no separation or search is made. Should applicants show or urge otherwise in the next response to this application in order for it to be considered timely. An election of species, restriction or both of them will be made for the record as shown or urged.

IV. The disclosure in the specification shows that no new chemical ingredient is disclosed or applied in the invention.

V. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed

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functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language “electrically and thermally conductive core”, “active area”, “electrically and thermally conductive polymeric composite”, “heat transfer” or the like is considered as the functional and characteristic, chemical and/or physical property of a material and searched as it appeared.

(B) In re Schreiber, 44 USPQ2d 1429 state that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” An argument may be given a little to no value. Applicants are now notified.

VI. Applicants’ supplemental prior art submissions filed on 15 March and 26 April 2004 have been considered in English language as provided.

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VII. An initial search has found about two dozens of the references that would be able to applied on at least the broadest independent claim 1. A set of at least three references will be applied when each and all applied references on the record are overcome.

VIII. Claims (1-6 and 8-10), (11-13 and 15-16), (17-39), (40-60), (61), (62), (63-76) and (77-89) with the broadest independent claim 1 as the main invention are rejected under 35 U.S.C. 103(a) as being unpatentable over Fronk et al (6,372,376), Ledjeff et al (5,733,678) and Landi et al (5,223,568).

Fronk et al disclose, teach and suggest a structure comprising at least two different kinds materials being next or substantially next to each other. Each of the materials has an uncovering or free body portion and is (electrically and thermally conductive to one having skilled in the art. Applicants are urged to show or provide a convincing evidence to the contrary as clearly pointed out and set forth in the above paragraph "V" above). Please see the whole disclosure of each of the applied references, especially in Fronk et al at the figures and their descriptions. For additive materials and their equivalent functional properties in an electrochemical power, please see Ledjeff et al,... especially at col.1:58 to 9:53. For the disclosed polymers in the invention, please see Landi et al..., especially at col.1:30 to 5:53. Other materials are known for their function and usefulness in the art. Applicants are urged to show or provide a convincing evidence that each of the claimed materials would provide an unusual or unexpected result over each of the equivalent materials for the same of about the same function from the above applied references or those in the submitted references on the record for a patentability of each of the claimed materials in order for each of them in the next response to this Office

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action in order for each of them to be considered timely. Any issue being newly raised after a final Office action would be late and not considered. Applicants are now notified. Since the above references are related to electrochemical powers, it would have been obvious to one having ordinary skill in the art to cite one or more conventional or known functional materials in the art for about the same result as known and applied in the art with no patentable value. For the newly added "heat transfer area extending beyond the active area", please see Fronk et al at figure 1, plate "8", especially at the outer portions of "20" and "22", figure 2, especially at the outer portions of "64", "66", "72", "74", "80", and "82". The law required that applicants must provide an evidence to the contrary of the applied inherent property (or close to it) of a material for the patentability of the claims as clearly stated out and set forth in paragraph "V" above. It is urged that applicants early come forth ward with a convincing evidence to the contrary to speed up the prosecution and to avoid any later work because a claim would have and be given a little to no value if someone could be later able to show, provide or produce an inherent property (or close to it) of a material. No evidence will be considered after the first response to this final Office action. It is now notified.

IX. Applicant's arguments filed 09 June 2004 have been fully considered but they are not persuasive.

Applicants urge that Fronk et al fails to cite the property material with respect to the newly added "heat transfer area extending beyond the active area". Please see Fronk et al at figure 1, plate "8", especially at the outer portions of "20" and "22", figure 2, especially at the outer portions of "64", "66", "72", "74", "80", and "82". The arguments

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alone have and are given a little to no value. The law requires that applicants must provide an evidence to the contrary for an inherent property (or close to it) of a material for the patentability of the claims as clearly stated out and set forth in paragraph "V" above.

It is urged that applicants early come forth ward with a convincing evidence to the contrary to speed up the prosecution and to avoid any later work because a claim would have and be given a little to no value if someone could be later able to show, provide or produce an inherent property (or close to it) of a material from a piece of a prior art.

No evidence will be considered after the first response to this final Office action. It is now notified.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
07 July 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le